



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

## CORRECTED NOTICE OF ALLOWANCE AND FEE(S) DUE

32361 7590 03/21/2006

GREENBERG TRAURIG, LLP  
MET LIFE BUILDING  
200 PARK AVENUE  
NEW YORK, NY 10166

EXAMINER	
CABECA, JOHN W	
ART UNIT	PAPER NUMBER
2173	DATE MAILED: 03/21/2006

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/429,585	10/28/1999	THOMAS J. SHAFRON	85804-014601	6107

TITLE OF INVENTION: METHOD OF CONTROLLING AN INTERNET BROWSER INTERFACE AND A CONTROLLABLE BROWSER INTERFACE

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	YES	\$700	\$0	\$700	06/21/2006

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

### HOW TO REPLY TO THIS NOTICE:

#### I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

**IMPORTANT REMINDER:** Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

**PART B - FEE(S) TRANSMITTAL**

Complete and send this form, together with applicable fee(s), to: **Mall** Mail Stop ISSUE FEE  
**Commissioner for Patents**  
**P.O. Box 1450**  
**Alexandria, Virginia 22313-1450**  
**or Fax** (571)-273-2885

**INSTRUCTIONS:** This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

32361 7590 03/21/2006

**GREENBERG TRAURIG, LLP**  
**MET LIFE BUILDING**  
**200 PARK AVENUE**  
**NEW YORK, NY 10166**

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

**Certificate of Mailing or Transmission**

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

(Depositor's name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/429,585	10/28/1999	THOMAS J. SHAFRON	85804-014601	6107

TITLE OF INVENTION: METHOD OF CONTROLLING AN INTERNET BROWSER INTERFACE AND A CONTROLLABLE BROWSER INTERFACE

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	YES	\$700	\$0	\$700	06/21/2006
EXAMINER	ART UNIT	CLASS-SUBCLASS			
CABECA, JOHN W	2173	715-826000			

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

- Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.  
 "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a Customer Number is required.

2. For printing on the patent front page, list

- (1) the names of up to 3 registered patent attorneys or agents OR, alternatively,  
(2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent):  Individual  Corporation or other private group entity  Government

4a. The following fee(s) are enclosed:

- Issue Fee  
 Publication Fee (No small entity discount permitted)  
 Advance Order - # of Copies \_\_\_\_\_

4b. Payment of Fee(s):

- A check in the amount of the fee(s) is enclosed.  
 Payment by credit card. Form PTO-2038 is attached.  
 The Director is hereby authorized by charge the required fee(s), or credit any overpayment, to Deposit Account Number \_\_\_\_\_ (enclose an extra copy of this form).

5. Change in Entity Status (from status indicated above)

- a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27.  b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

The Director of the USPTO is requested to apply the Issue Fee and Publication Fee (if any) or to re-apply any previously paid issue fee to the application identified above.

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature \_\_\_\_\_

Date \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Registration No. \_\_\_\_\_

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/429,585	10/28/1999	THOMAS J. SHAFRON	85804-014601	6107
32361	7590	03/21/2006	EXAMINER	
GREENBERG TRAURIG, LLP MET LIFE BUILDING 200 PARK AVENUE NEW YORK, NY 10166				CABECA, JOHN W
ART UNIT		PAPER NUMBER		
		2173		
DATE MAILED: 03/21/2006				

## Determination of Patent Term Extension under 35 U.S.C. 154 (b) (application filed after June 7, 1995 but prior to May 29, 2000)

The Patent Term Extension is 0 day(s). Any patent to issue from the above-identified application will include an indication of the 0 day extension on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Extension is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

<b>Notice of Allowability</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/429,585	SHAFRON, THOMAS J.	#27
	<b>Examiner</b>	Art Unit	
	Brian J Detwiler	2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTO-85) or other appropriate communication will be mailed in due course. THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS. This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1.  This communication is responsive to the amendment filed 9 March 2004.
2.  The allowed claim(s) is/are 87-112.
3.  The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4.  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All
  - b)  Some\*
  - c)  None
  1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

5.  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - (a)  The translation of the foreign language provisional application has been received.
6.  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

7.  A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8.  CORRECTED DRAWINGS must be submitted.
  - (a)  including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1)  hereto or 2)  to Paper No. \_\_\_\_\_.
  - (b)  including changes required by the proposed drawing correction filed \_\_\_\_\_, which has been approved by the Examiner.
  - (c)  Including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet.

9.  DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

#### Attachment(s)

- |   |   |
|---|---|
| <input type="checkbox"/> Notice of References Cited (PTO-892)   | <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)          |
| <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                               | <input type="checkbox"/> Interview Summary (PTO-413), Paper No. _____.            |
| <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449), Paper No. _____.              | <input checked="" type="checkbox"/> Examiner's Amendment/Comment                  |
| <input checked="" type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
|   | <input type="checkbox"/> Other  |

#### EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with James DeCarlo on 9 July 2004. Cancellations of certain claims have been made without prejudice.

The application has been amended as follows:

Cancel claims 53-68, 77-86, and 113.

In claim 95, line 3: replace "having" with -- comprising: --.

In claim 95, line 10: insert -- and download of one or more files from -- between "enabled via connection to" and "said predetermined Internet site".

In claim 95, line 10: replace "including a persistent user toolbar" with -- said one or more files causing a persistent user toolbar to be displayed --.

In claim 111, line 14: insert -- a user toolbar comprising -- immediately before "a user interface object".

In claim 111, line 19: replace "interface object" with -- toolbar --.

In the specification, page 25: line 5, replace "FIG. 8" with -- FIG. 8A --.

In the specification, page 25: line 6, replace "FIG. 8" with -- FIG. 8A --.

In the specification, page 25: line 16, replace "FIG. 8A" with -- FIG. 8B --.

In the specification, page 25: line 22, replace "FIG. 8" with -- FIG. 8A --.

In the specification, page 26: line 10, replace "FIGS. 8, 8A" with -- FIGS. 8A, 8B --.

In the specification, page 27: line 4, replace "FIG. 8" with -- FIG. 8A --.

The following changes to the drawings have been approved by the examiner and agreed upon by applicant: Renumber Figure 8 to Figure 8A; and renumber Figure 8A to Figure 8B. In order to avoid abandonment of the application, applicant must make these above agreed upon drawing changes.

*Reasons for Allowance*

The following is an examiner's statement of reasons for allowance: In combination with the claimed subject matter, the prior art does not teach or fairly suggest a file that is downloadable from a predetermined Internet site, which causes a user toolbar to be added to and displayed entirely within the bounds of a browser's user interface, such that the user toolbar does not overlay the display area or anything that was displayed in the bounds of the user interface prior to downloading. The closest prior art is the Alexa toolbar, which is disclosed in U.S. Patent No. 6,282,548 (Burner et al) and the Alexa Internet Website reference. While the Alexa toolbar could potentially be considered a part of the browser interface because it is simultaneously displayed with and is functionally dependent upon the browser, there does not appear to be evidence teaching or suggesting that the toolbar could be physically integrated within the bounds of the browser's interface as claimed. While the Burner reference goes so far as to say that the

Art Unit: 2173

Alexa toolbar can be an extension of the browser, it cannot be conclusively determined that Alexa's toolbar alone or in combination is capable of anticipating the claimed invention.

***Conclusion***

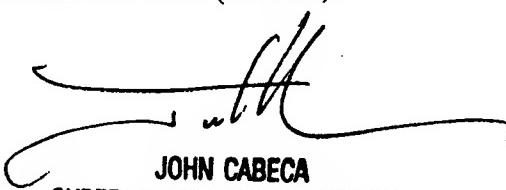
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Detwiler whose telephone number is 571-272-4049. The examiner can normally be reached on Mon-Thu 8-5:30 and alternating Fridays 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Cabeca can be reached on 571-272-4048. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bjd

  
JOHN CABECA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

Docket No.  
**694231/0002**  
(JJD)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: : **Thomas J. Shafron**

Art Unit: **2173**

Application No.: **09/429,585**

Examiner: **Brian J. Detwiler**

Filed: **October 28, 1999**

For: **METHOD OF CONTROLLING AN INTERNET BROWSER  
INTERFACE AND A CONTROLLABLE BROWSER  
INTERFACE**

Date: February 26, 2004

**DECLARATION UNDER 37 C.F.R. § 1.132**  
**OF EDWARD F. SEITZ**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1

Sir:

I, Edward F. Seitz, declare as follows:

1. I am an employee of Yahoo! Inc., the assignee of the above-referenced patent application. My title is Engineering Director, and I am responsible for Client Kit Software Development.
2. I currently reside at 3934 Flowerland Dr., Atlanta, GA 30319.
3. I make this Declaration in support of the above-referenced currently pending application and in connection with certain rejections made by the Examiner in which the Examiner has stated that certain features of the invention are either obvious or anticipated over the prior art.
4. My educational background is as follows: I received a B.S. degree in 1987 from the University of Illinois where I majored in Aeronautical and Astronautical Engineering.

My engineering curriculum included courses involving programming and developing or using software applications to solve engineering problems.

5. After graduation I worked for Boeing Aerospace in Seattle where I performed wind tunnel testing and data analysis. I developed software, in Fortran and C, to perform test data analysis and became interested in pursuing a career in software development at this time. Independently, I studied Windows Programming Development in C, and found a position in 1990 developing Windows Applications. Since 1990, I have been working on the Microsoft Windows platform, working on several projects as a technical lead. Many of the products I have developed were made for widespread retail distribution, some of which received awards from various trade publications. In 1996, I started to work on projects that included Internet connectivity and later I started working at, and was a cofounder of, a company whose products included a web browser based on Internet Explorer. I joined Yahoo! in 1999. To date, my experience and responsibilities have focused primarily on applications that have an Internet component with a focus on widespread distribution of such programs.

6. As a result of my education and background I have substantial experience in programming of computers and computer application software, especially the programming and scripting of personal computer based applications using graphical user interfaces (GUI), such as the Windows operating system provided by Microsoft Corporation. I am also familiar, and have been familiar, with the Internet and Internet related software such as browsers, since at least 1996.

7. I believe that a person of skill in the art to which the pending application is directed, namely software for enhancing a user's experience with the Internet, in October of 1998 at the time of filing of the provisional patent application from which the above-referenced patent application claims priority, would be a person with an undergraduate degree in

Computer Science or Engineering, having taken sufficient course work to develop a proficiency in programming and/or scripting, along with several years of pertinent experience writing GUI-based applications in the Windows or Apple environment, along with a working understanding of the Internet and programs capable of operating over and with the Internet, such as commercially available Internet browsers like Explorer and Netscape.

8. I believe that my background and experience is at least that of the hypothetical person described in the preceding paragraph, and that I can read and understand related patent documents and articles, and understand and interpret them, as a person of skill in the art would.

9. One of the references cited by the Examiner is U.S. Patent No. 6,282,548 to Burner et al. I have reviewed this patent and the rejections set forth by the Examiner and disagree with the Examiner's position with respect to how a person of skill in the art would understand the use of certain terms pointed out by the Examiner in the Burner reference.

10. Specifically, the Examiner takes the position that the Burner reference, which teaches a client software program for displaying a downloadable toolbar that exists in a separate window within a Windows operating system environment, and that provides certain "metadata" information to a user while they browse the Internet, renders the claimed invention anticipated or obvious based on the Examiner's interpretation of certain terms used in the Burner reference.

11. First, the Examiner points to the use of the term "plug-in" in the Burner reference. As indicated by the attached definitions annexed hereto as Exhibits A and B, the term "plug-in" to a person of skill in the art in October of 1998 would merely connote an application program that could be added to a computer system and connected to a browser application to add functionality to the browser application, such as a media player, which was

the most common type of plug-in at the time. The fact that the client side software that generates the Burner toolbar could be implemented as a “plug-in” does not in any way teach or suggest or describe a downloadable toolbar that can be incorporated as part of the browser user interface, as are the inventions set forth in claims 53-86 of the currently pending application. The term “browser plug-in” does not mean something that is added to a browser user interface, it merely means software that runs on a client computer with a browser to add functionality to the browser. It is respectfully submitted that the Examiner is incorrect in his technical understanding of the term “plug-in” as evidenced by the attached common definitions, and has thus applied an untenable meaning to that term in the context of the Burner reference.

12. The situation is the same with respect to the term “extension”. As demonstrated by the definitions annexed hereto as Exhibits C and D, an extension is merely an item of software that is used to extend or increase the functionality of an existing software program. Thus the fact that the Burner reference teaches that the Burner toolbar which exists in a separate window can be implemented through client side software that operates as an “extension” of the browser does not describe nor teach nor suggest, nor would it motivate a person of skill in the art in October of 1998, that they should implement the Burner toolbar as incorporated as part of the browser user interface as claimed. The fact that the client side software that generates the Burner toolbar could be implemented as an “extension” does not in any way teach or suggest or describe a downloadable toolbar that can be incorporated into the browser user interface as part of the browser interface, as is the invention set forth in claims 53-86 of the currently pending application. The term “extension” does not mean something that is added to a browser user interface as part of the browser interface, it merely means software that runs on a client computer with a browser to add functionality to the browser. It is respectfully submitted that the Examiner is incorrect in his technical understanding of the term “extension”

as evidenced by the attached common definitions, and has thus applied an untenable meaning to that term in the context of the Burner reference.

13. The Examiner takes the same position in connection with the term “secondary instance window”. While the term secondary instance window is not a common term, as used in the context of the Burner patent at column 8, lines 23-37, my understanding of a “secondary instance window” is merely the opening of a second browser window using a windows-based operating system, which is how the Burner toolbar is shown and described in the preferred embodiments of the Burner patent. The fact that the described “secondary instance window” is used as an alternative to the proxy server embodiment described earlier in column 8 at lines 8 through 22 suggests that the term “secondary instance window” is just the opening of a second browser. Thus a “secondary instance window” as used in the Burner patent is just the separate window described in the Burner reference and does not in any way describe or teach or suggest that the floating toolbar of Burner should be implemented as part of the browser user interface as claimed in claims 53 to 86.

14. The same arguments set forth with respect to “plug-in” and “extension” are equally applicable to term “secondary instance window” in that all of these terms, as understood at the time that the present application was filed, merely refer to different ways of implementing the client side software that generates the separate toolbar described in the Burner reference. These terms do not, and did not at the time of filing, in any way connote the adding of a user toolbar or interface object to the browser interface as part of the browser interface as claimed.

15. An additional reason why a person of skill would not have interpreted the above-noted three terms in the way that the Examiner has is that while it is now common for browser software to include tools or Application Programming Interfaces (API’s) that permits

end-users or software developers to modify the browser interface by inserting toolbars or interface objects that are not part of the native browser software, it is my understanding that this capability was not available until after the filing of the present patent application. Thus, for this additional reason, it is respectfully submitted that the Examiner is incorrect in his technical assertions as to what the terms "plug-in", "extension", and "secondary instance window" would have actually meant to a person of ordinary skill in the art at the time the present patent application was filed. Quite simply, none of those terms could have connoted or suggested a modification of the browser interface since no browser incorporated utilities to permit such modification and in fact, it is my opinion that it is because of these closed browser software systems that Burner implemented his downloadable toolbar as a floating window outside of or overlying the browser environment as opposed to appearing as a part of the browser user interface as presently claimed. In fact, I have seen certain user group threads that are being submitted concurrently as part of an Information Disclosure Statement and which are also attached hereto as Exhibit E. A number of these threads, which are dated after October 28, 1998, are referring to a commercial embodiment of the claimed invention known as Yahoo! Companion. These threads clearly demonstrate that even after the filing date, and after the commercial deployment of an embodiment of the invention, it was not commonly recognized that toolbars could be added to the browser interface. Indeed, none of the threads actually describe a solution.

16. Additionally, the language of Burner at column 7, line 63, to column 8, line 4, suggests that Burner did not contemplate any other implementation than a separate window outside the browser interface. Nothing in the Burner patent suggests otherwise, and only the separate window embodiment is described, thus there is absolutely nothing in that reference to suggest incorporating the Burner toolbar as part of the browser interface.

17. Further, with respect to the incorporation of a search window into the user toolbar, the Examiner points to the search facility that existed in Internet Explorer 4 and as described in the Que reference that describes the Explorer search function. This functionality is starkly different from the claimed functionality of incorporating a search window into a downloadable toolbar or interface object so as to permit an end-user to conduct a search directly by entering a search term into a search term field present in the user toolbar or interface object added as part of the browser interface which would cause a search to be initiated at a predetermined site, generally and preferably the site that supplied the downloadable user toolbar as a way to instill user loyalty and promote “stickiness” of the application to the site that provides the downloadable user toolbar. The functionality described in the Internet Explorer 4 reference was for an Explorer bar, which is different from a toolbar, and which, when the “search” function was selected from the browser interface, caused an additional window pane to open up in the browser web page content display area which then displayed a dropdown menu having pre-programmed search sites that a user might wish to conduct a search at. After choosing a site from the dropdown menu a separate content display area would appear in the browser content display area which would be an HTML page provided by the selected search service provider. The user could then, in a traditional manner, enter the search term in the search term entry field of the HTML page provided by the search service, and a search would be conducted. The search result would appear in the separate window pane as an ordinary HTML page. This is starkly different from the claimed invention.

18. In claims 58, 64 and 83, the search window is incorporated into the user toolbar or appears as an interface object as part of the browser interface so that an end-user can type the search term directly into the search window and a search would be conducted at a predetermined website. This can be done, after the downloadable toolbar or interface object

was installed, without the user having to (i) click to get a dropdown menu, then (ii) select one of a group of available search services, (iii) wait for a window to open and page to load, and only then (iv) enter terms into the search window of the search page provided by the search service. I believe that a person of skill in the art in 1998 (or even now) would in no way consider the cumbersome method described in the Que reference as in any way describing or teaching or suggesting the claimed invention, which makes the search window always available regardless of where the user is navigating, and allows the user to enter a search term without any clicks or menu selection.

19. With respect to the Belfiore reference, U.S. Patent No. 6,009,459, that reference merely discloses a system that works in concert with a feature that is incorporated into the native Explorer browser that causes the browser to execute a search if the term entered into the browser address bar is not a known URL. If the term entered into the browser address bar is a known URL, the page is served as usual. If the term entered into the browser address bar returns an error, meaning the URL is not known, the browser tries to format the term into a proper URL, and if that is unsuccessful, the system will then apply a template to construct a search engine query to search for terms entered by the user at a search engine decided by the Browser provider.

20. I believe that a person of skill in November of 1998 reading the Belfiore reference would not consider the address bar of the Explorer browser to describe or teach or suggest the invention as presently claimed in claims 58, 64 and 83 which are directed to the provision of a search window that is incorporated into a downloadable toolbar or interface object and that permits search terms to be entered knowing that the search will be provided at the predetermined website from which the download was obtained. In the presently claimed invention, the user knows that when text is entered a search will be performed. The Belfiore

(Microsoft IE) system does not ensure that when text is entered a search will be performed, but rather if a term is entered that matches a URL, a new page will be served. With the presently claimed invention, when a search term is entered, a search is performed, with the user expectation that a search result will be returned. I believe that a person of skill in the art would consider this is quite different from what is taught by Belfiore, as do I.

21. Moreover, if the Explorer browser address bar of Belfiore were considered a search window as the Examiner suggests, (which I do not believe it is), then a person of skill reading Belfiore would not be motivated to add yet another search window to the browser, since a second search window would be redundant. Thus rather than motivate a person of skill to add a search window to a browser user interface via a downloadable toolbar or interface object, Belfiore, if interpreted as the Examiner interprets it, in fact teaches away from such an addition.

22. I declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: \_\_\_\_\_

By: \_\_\_\_\_  
Edward F. Seitz